

REMARKS

Claims 3-11, 13-16, and 22-25, and 33-36 are pending. Claims 26 to 29 and 32 are currently canceled without prejudice. Claims 1, 2, 12, 17-21, 30, and 31 were previously canceled. Claims 24, 25, and 33-36 are currently amended without prejudice.

Reconsideration of the application, as amended, is requested.

Support for the amendments to claims 24, 25, and 33-36 with respect to the limitation "where R¹ is hydroxyalkyl, dihydroxypropyl, or polyalkylenepolyamine and R² is hydrogen or R¹" or "where(in) R¹ is hydroxyalkyl, dihydroxypropyl, or polyalkylenepolyamine, and R² is hydrogen" can be found in the specification, for example, page 6, line 20. Support for "dihydroxypropyl" can be found in the specification, for example, Examples 1 and 3 on page 19 and Example 7 on page 21, where "APD" is defined as 2-amino-1,3-propanediol on page 17.

§ 112 Rejections

Claims 3-11, 13-16, 22-25, and 33-35 stand rejected under 35 U.S.C. 112, first paragraph, as purportedly failing to comply with the written description requirement.

The Office Action states:

The examiner has reviewed the specification and has not found support for the R1 and R2 species, "dihydroxyalkyl", set forth within claims 24, 25, 33-35 (and nonelected claims 26 and 27). Despite applicants' response, "dihydroxyalkyl", is considered to be structurally distinct from the disclosed "hydroxyalkyl" and it is not seen that hydroxyalkyl is suggestive of dihydroxyalkyl. Furthermore, dihydroxyalkyl encompasses structures of far broader scope than dihydroxypropyl. Therefore, there is insufficient evidence on the record to establish that applicants were in possession of dihydroxyalkyl species other than dihydroxypropyl at the time of filing.

Although Applicants do not necessarily agree with the rejection, claims 24, 25, and 33-35 have been amended to replace the term "dihydroxyalkyl" with the term "dihydroxypropyl".

In summary, Applicants submit that this amendment overcomes the rejection of claims 3-11, 13-16, 22-25, and 33-35 under 35 USC § 112, first paragraph and request withdrawal of the rejection.

Double Patenting

Claims 3-11, 13-16, 22-25, and 33-36 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4, 6-10, and 18-24 of copending Application No. 10/729,073. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants may provide a terminal disclaimer, if appropriate, once one of the applications in question is allowed, and the rejection is no longer provisional.

§ 102 Rejections

Claims 5-11, 13-16, 22-25, and 36 stand rejected under 35 USC § 102(e) as purportedly anticipated by Moore et al. (U.S. Patent No. 6,649,272).

Applicants respectfully traverse the rejection of claims 24 and 25 under 35 USC § 102(e) as being anticipated by Moore et al. at least because the reference does not disclose a composition as described in claim 24 or claim 25, as amended.

The composition, as recited in amended claims 24 and 25, comprises a perfluoropolyether urethane or urea silane, or a mixture thereof which is the reaction product of a specific fluorinated polyether compound of formula (I) that includes carboxylic acid ester or carboxamide groups and isocyanate reactive groups (T and T') and a specific silane compound of formula (II). The amendments to claims 24 and 25 eliminate the possibility that both R¹ and R² can be hydrogen, and thereby more clearly differentiate these claims from Moore et al.

At least because Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II), the reference does not anticipate Applicants' amended claims 24 and 25.

Claims 5-11, 13-16, 22, 23, and 36 all depend, either directly or indirectly, from claim 24 or 25. Thus, each of these claims is patentable at least on the basis of this dependency from a patentable base claim.

In view of the above, the rejection of claims 5-11, 13-16, 22-25, and 36 under 35 USC § 102(e) as being anticipated by Moore et al. (U.S. Patent No. 6,649,272) has been overcome and should be withdrawn.

§ 103 Rejections

Claim 4 stands rejected under 35 USC § 103(a) as purportedly unpatentable over Moore et al. (U.S. Pat. No. 6,649,272) in view of Brown (U.S. Pat. No. 6,495,624) or Scicchitano et al. (US2002/0016267) or WO 01/34670.

As stated above in response to the rejection of claims 5 – 11, 13 – 16, 22 – 25, and 36 under 35 USC § 102(e), Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown, Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the present application are nonobvious over Moore et al., in view of Brown or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

The rejection of claim 4 under 35 USC § 103(a) as being unpatentable over Moore et al. (U.S. Pat. No. 6,649,272) in view of Brown (U.S. Pat. No. 6,495,624) or Scicchitano et al. (US2002/0016267) or WO 01/34670 has been overcome and should be withdrawn.

Claim 3 stands rejected under 35 USC § 103(a) as purportedly unpatentable over Moore et al. (U.S. Pat. No. 6,649,272) in view of Brown (U.S. Pat. No. 6,495,624) or Scicchitano et al. (US2002/0016267) or WO 01/34670 and further in view of WO 01/30873.

As stated above in response to the rejection of claims 5 – 11, 13 – 16, 22 – 25, and 36 under 35 USC § 102(e), Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown, Scicchitano et al. (US 2002/0016267), WO 01/34670, nor WO 01/30873 remedy this deficiency. Therefore, the claims of the present application are nonobvious over Moore et al., in view of Brown or Scicchitano et al. (US 2002/0016267) or WO 01/34670 and further in view of WO 01/30873.

The rejection of claim 3 under 35 USC § 103(a) as being unpatentable over Moore et al. (U.S. Pat. No. 6,649,272) in view of Brown (U.S. Pat. No. 6,495,624) or Scicchitano et al. (US2002/0016267) or WO 01/34670 and further in view of WO 01/30873 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application, as amended, is requested.

Respectfully submitted,

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